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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,274	09/28/2006	Zhong-Min Wei	21829/222	9418
7590 10/07/2010				
Nixon Peabody Clinton Square PO Box 31051 Rochester, NY 14603-1051			EXAMINER PRYOR, ALTON NATHANIEL	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 10/07/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/538,274

**Applicant(s)**

WEI, ZHONG-MIN

**Examiner**

ALTON N. PRYOR

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 15, 24, 41, 48-58, 65, 74, 91 and 98-119 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 49, 50, 53-58, 99-101, 106 and 114 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/1/10, 1/2/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims **withdrawn** from consideration are 15,24,41,48,51,52,65,74,91,98,102-105,107-113 and 115-119.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8,49,50,53-58,99-101,106 and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al (USPN 6001959) and Zitter et al. (WO 98/37752; 9/3/98), Wei et al. (USPN 6624139; 9/23/2003, see claims 1-9), Wei et al. (USPN 6235974; 5/22/01 see claims 1-11,15, 23-25,33 and 35), Qui et al. (USPN 6277814; 8/21/01, see column 25 lines 23-40, Examples 1, 11,12,13 and claims 1-10,14 and 17). Wei et al. (USPN 5776889; 7/7/98, see claims 1 and 23), Zitter et al. (USPN 5977060; 11/2/99 see claims 1 and 17), Wei et al. (USPN 5858324; 1/12/99, see column 6-8, column 19 line 62 – column 20), Wei et al. (USAN 2002/0059658; 5/16/02, column, abstract, paragraphs 17,18,22,24,46), Wei et al. (USPN 6960705; 11/1/05), see column 3 lines 25-57, column 4 line 50 – column 6, column 14 lines 37-49, column 18 lines 51-56, column 19 lines 32-37) and/or Fan et al. (USAN 2002/0062500; 5/23/02, see paragraphs 13,21,27-28,78,88).

Bauer et al. suggests that a hypersensitive response elicitor polypeptide derived from *Erwinia amylovora* along with an agricultural chemical can be applied to crop (transgenic) such as corn. Such combination of chemicals would automatically increase the efficacy of the agricultural chemicals. Bauer et al. does not teach herbicide as the

pesticide. The numerous other cited references establish the ease of including herbicide as the agricultural. It would have been obvious to modify the invention taught by Bauer to include a herbicide suggested in the other references cited above.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8,49,50,53-58,99-101,106 and 114 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. USPN 6277814; claims 1-10,14 and 17). Wei et al. (USPN 5776889; 7/7/98, see claims 1 and 23), Zitter et al. (USPN 5977060; 11/2/99 see claims 1 and 17), Wei et al. (USPN 5858324; 1/12/99, see claims. Although the conflicting claims are not identical, they are not patentably distinct from each other because USPNs make claim to a hypersensitive response elicitor polypeptide derived from *Erwinia amylovora* being combined with an agricultural chemical can be applied to crop (transgenic) such as corn. Such combination of chemicals would automatically increase the efficacy of the agricultural chemicals.

Claims 1-8,49,50,53-58,99-101,106 and 114 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 12/536750. Although the conflicting claims are not identical, they are not patentably distinct from each other because USPNs make claim to a hypersensitive response elicitor polypeptide derived from *Erwinia amylovora* being combined with an agricultural chemical can be applied to crop (transgenic) such as corn. Such combination of chemicals would automatically increase the efficacy of the agricultural chemicals.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALTON N. PRYOR whose telephone number is (571)272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/  
Primary Examiner, Art Unit 1616

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